



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:  
Zhou Yang et al.

Serial No: 09/280,601

Filed: March 29, 1999

For: OPTICAL TERPOLYMER OF POLY-  
ISOCYANATE, POLYTHIOL AND  
POLYENE MONOMERS

Appeal No.: 2003-0365

DATE: April 21, 2003

BOARD OF PATENT  
APPEALS &  
INTERFERENCES  
MAY 16 2003

RECEIVED  
2003 MAY - 1 AM 10: 24  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**REQUEST FOR REHEARING AND CLARIFICATION  
UNDER 37 C.F.R. 1.197(b)**

Rehearing and clarification is respectfully requested under 37 C.F.R. 1.97(b) for the Board's DECISION ON APPEAL mailed February 25, 2003 for the subject patent application (the "Decision").

**Points believed to have been misapprehended or overlooked**

It is believed that the Decision is unclear because the Board stated on page 6 thereof that "the Examiner's decision rejecting the appealed claims is affirmed." However, the Examiner's rejection of claims 116, 117, 124-132, 134 and 135 under 35 USC, 112, first paragraph, was not sustained by the Board and it is therefore believed that the Decision should have concluded that the Examiner's rejections had been Affirmed-In-Part and Reversed-In-Part.

**Discussion**

Specifically, the Examiner's rejection of claims 116, 117, 124-132, 134 and 135 under 35 USC 112, first paragraph, was not sustained as set forth on page 4 of the

Decision because the Board found no basis for the Examiner's conclusion that the claim language "constitutes new matter when not presented with the structural formula which contains only vinyl functional groups". The Board noted that in their view, the structural formula in the parent application provides descriptive support for the language that the polyene contains only vinyl functional groups. The Board stated flatly that "[w]e will not sustain the examiner's rejection of claims 116, 117, 124-132, 134 and 135 under 35 USC 112, first paragraph." Decision, page 4. Accordingly, it is Appellants' understanding based on the Decision that claims 116, 117, 124-132, 134 and 135 are proper under 35 USC 112, first paragraph, with regard to the definition of the polyene monomer.

Confirmation and clarification by the Board of this understanding is important because Appellants have the opportunity to file a continuation of the subject application and obtain allowance with respect to claims 116-133. With the Board's reversal of the Examiner's rejection under 35 USC 112, first paragraph: i) claims 116-120 and 123-132 stand rejected only for obviousness-type double patenting (sustained in Decision, page 6) and ii) claims 121, 122 and 133 stand rejected for both obviousness-type double patenting and for failure to comply with 35 USC 112, second paragraph (Decision, page 3, item (a)). In such continuation application, Appellants may file a terminal disclaimer and amend the objected-to language of claims 121, 122 and 133, to place claims 116-133 in condition for allowance.

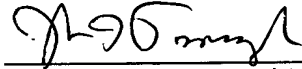
### **Summary**

For the reasons given above, Appellants respectfully submit that claims 116, 117, 124-132, 134 and 135 are proper under 35 USC 112, first paragraph, regarding the definition of the polyene monomer of the claims and that the polyene monomer may be defined as in claim 116 as containing only vinyl functional groups.

Accordingly, it is respectfully submitted that the Board's decision be amended to clarify this reversal of the Examiner's rejection of these claims.

The Board is hereby authorized to charge any fee for this Request to Deposit Account No. 04-0566. Three copies of the Request are enclosed.

Respectfully submitted,

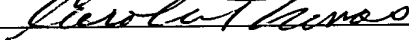


John J. Tomaszewski  
Reg. No. 26,241

**DeLIO & PETERSON, LLC**  
121 Whitney Avenue  
New Haven, CT 06510-1241  
(203)787-0595

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231

Name: Carol M. Thomas Date: April 21, 2003 Signature:   
opt20500ReqHear&Clarif